



Gp/1646

PATENT
Customer Number 22,833
Attorney Docket No. 17694.0004

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J.G.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Johan LENNERSTRAND et al.) Group Art Unit: 1648
)
Application No.: 09/599,877) Examiner: J. Parkin
)
Filed: June 23, 2000)
)
For: METHOD FOR DETERMINING)
THE MECHANISM OF HIV RT)
INHIBITORS)
)
)
)

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action dated October 2, 2001, Applicants respectfully request reconsideration of the subject application in light of the following remarks. Claims 1-21 are pending in this application. In the Office Action, the Office required restriction under 35 U.S.C. § 121 to one of the following groups of claims:

- a. Group I, claim(s) 1-14, drawn to a method for assessing HIV viral drug resistance to reverse transcriptase (RT) inhibitors, classified in class 435, subclass 7.4.
- b. Group II, claim(s) 15 and 16, drawn to a method for determining the proper course of therapy for an HIV-infected patient, classified in class 435, subclass 5.
- c. Group III, claim(s) 17 and 18, drawn to a kit for detecting HIV variants that are resistant to RT inhibitors, classified in class 422, subclass 61.
- d. Group IV, claims(s) 19, drawn to a method for determining 'the

- mechanism of action of an RT inhibitor, classified in class 435, subclass 6.
- e. Group V, claim(s) 20 and 21, drawn to a method for determining the effects of RT mutations on drug resistance, classified in class 435, subclass 7.6.

The restriction requirement is respectfully traversed. However, to be fully responsive to the restriction requirement, Applicants provisionally elect to prosecute Group I, Claims 1-14.

The Applicants refer the Office to M.P.E.P. § 803, which sets forth the criteria and guidelines for the Office to follow in making proper requirements for restriction. The M.P.E.P. instructs the Office as follows:

If the search and examination of an entire application can be made without **serious burden**, the Office **must** examine it on the merits, even though it includes claims to distinct or independent inventions.

M.P.E.P. § 803 (emphasis added).

The Office has not shown that examining Groups I - V would constitute a serious burden. For example, as the Office states, Groups I, II, IV, and V are classified as part of the same class, *i.e.*, 435, and Groups I and V are classified as part of the same class and the same subclass, *i.e.*, class 435, subclass 7. It is not understood how the Office can possibly argue that searching the same class and subclass constitutes a serious burden.

At the very least, the Office should examine Groups I and V in response to the Applicants election, with traverse, of the subject matter of Group I, claims 1-14. Again, the critical issue is not whether these groups are unrelated but whether there is a

serious burden to the Office in examining the Groups together. In view of the foregoing remarks, Applicants respectfully request that the requirement be withdrawn.

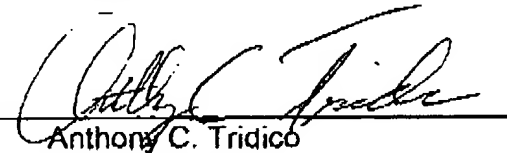
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 31, 2001

By:



Anthony C. Tridico
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